

Patent Application No. 09/897,801
Response to June 10, 2004 Office Action
October 6, 2004

Remarks

Applicant requests consideration on the merits of the above-referenced patent application.

I. Response to the rejection of claims 85, 90, 91, 95-97, 99, 102, 106-108, 110, 113, 119, 121, 124-126, 129, 131, and 134-136 under 35 U.S.C. §102(e)

Claims 85, 90, 91, 95-97, 99, 102, 106-108, 110, 113, 119, 121, 124-126, 129, 131, and 134-136 have been rejected under 35 U.S.C. §102(e) for lacking novelty in view of WO 02/02718. Applicant requests reconsideration of this rejection.

Applicant believes that WO 02/02718 has improperly been cited as a §102(e) reference. More specifically, §102(e) only applies if the §102(e) date of the cited reference precedes the filing date of Applicant's application. In this instance, WO 02/02718 was filed on June 29, 2001, which is the same date as Applicant's filing date. Thus, §102(e) does not apply, assuming that the §102(e) date of WO 02/02718 is its filing date. Although WO 02/02718 does reportedly claim priority to an earlier application (U.S. Patent Appl. No. 09/606,909), that application was filed on June 29, 2000. The MPEP is silent as to the proper §102(e) date of a PCT application in this specific situation where the PCT application claims priority to a U.S. application filed before November 29, 2000. The MPEP, however, does address the analogous situation where the priority application is another PCT application filed before November 29, 2000. The MPEP states that the §102(e) date in that situation is the international filing date of the later PCT application --- not the filing date of the priority PCT application. Specifically, MPEP §706.02(f)(1) states:

[W]here the earlier application is an international application, the earlier international application must satisfy the same three conditions (i.e., filed on or after November 29, 2000, designated the U.S., and had been published in English under PCT Article 21(2)) for the earlier international filing date to be a U.S. filing date for prior art purposes under 35 U.S.C. 102(e). (emphasis added)

By analogy, if a PCT application claims priority to a U.S. application filed before November 29, 2000 (as is the case with WO 02/02718), the PCT application's §102(e) date should be

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that PCT application's international filing date, not the filing date of the priority U.S. application. Thus, Applicant believes that the §102(e) date of WO 02/02718 is June 29, 2001 (*i.e.*, its international filing date). As noted above, because Applicant's application was also filed on June 29, 2001, Applicant submits that WO 02/02718 should not be a §102(e) reference against Applicant's application.

II. Response to the rejection of claims 85, 90, 91, 95-97, 99, 102, 106-108, 110, 113, 119, 121, 124-126, 129, 131, and 134-136 under 35 U.S.C. §103(a)

Claims 85, 90, 91, 95-97, 99, 102, 106-108, 110, 113, 119, 121, 124-126, 129, 131, and 134-136 have been rejected under 35 U.S.C. §103(a) for being prima facie obvious in view of WO 02/02718. Applicant requests reconsideration of this rejection. As discussed above, Applicant believes that WO 02/02718 is not prior art under 35 U.S.C. §102. Thus, the rejection should be withdrawn.

III. Response to the provisional obviousness-type double patenting rejection of claims 85, 87-92, 94-97, 99-102, 105-108, 110-113, 119, 121-126, 128, 129, 131-136, and 138

Claims 85, 87-92, 94-97, 99-102, 105-108, 110-113, 119, 121-126, 128, 129, 131-136, and 138 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 and 44-77 of U.S. Patent Application No. 10/443,361. Applicant respectfully submits that this rejection is premature, given that U.S. Patent Application No. 10/443,361 has not yet issued as a patent. *See* MPEP §804.

* * * * *

Applicant authorizes the Commissioner to charge the \$110.00 fee for the one-month extension to Deposit Account No. 08-0750. Applicant believes that he/she does not owe any other fee(s) in connection with this submission. If, however, Applicant does owe any fee(s), the Commissioner is hereby authorized to charge the fee(s) to Deposit Account No. 08-0750. In addition, if there is ever any other fee deficiency or overpayment under 37 C.F.R. §1.16 or

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§1.17 in connection with this patent application, the Commissioner is hereby authorized to charge such deficiency or overpayment to Deposit Account No. 08-0750.

Applicant submits that the application is in condition for allowance, and requests that it be allowed. Applicant requests that the Examiner call the Undersigned if any issues arise that can be addressed over the phone to expedite examination of this application.

Respectfully submitted,



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I hereby certify that this correspondence is being facsimile transmitted to facsimile number 1 703 872 9306 addressed to **Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450** on October 6, 2004.



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